



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/750,598

12/30/2003

Norihiro Edwin Aoki

AOL0106

3370

22862

7590

07/19/2006

GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

EXAMINER

GAUTHIER, GERALD

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/750,598

Applicant(s)

AOKI, NORIHIRO EDWIN

Examiner

Gerald Gauthier

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 8, 2006 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim(s) 34, 48 and 63** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. **Claim(s) 34** recites the limitation "the messages' addressees" in line 6, "the messages" in line 11 and the addressee" in lines 18, 19 and 22. There is insufficient antecedent basis for this limitation in the claim. It is in the interest of the applicant to clarify which antecedent these limitations are referring to.

Claim(s) 48 has the same problem. It recites the limitation "the messages' addressees" in lines 7 and 8, "the messages" in line 12 and the addressee" in lines 21, 24 and 28.

Claim(s) 63 has the same problem. It recites the limitation "the method" in line 7, "the messages" in line 16, "the commercial partners" in line 17, "the given message's addressee" in lines 20, 21 and 27 and the addressee" in lines 21, 28, 29 and 30.

Claim(s) 35-47 and 49-62 are rejected for being dependent of rejected claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claim(s) 34-63** are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (US 5,999,932) in view of Council et al. (US 6,587,550 B2).

Regarding **claim(s) 34, 48 and 63**, Paul discloses a computer implemented method of operating a subscription manager to manage incoming machine readable messages arriving at a communications network having multiple remote user recipients (FIG. 1 and column 1, lines 7-20), the method comprising the operations of:

responsive to finding that a given message is a subscription type message, the given message having at least one addressee (column 9, lines 48-55), performing operations comprising:

determining whether the given message originated from a subscription source pre-approved by the given message's addressee for sending subscribed-to messages to the addressee (column 9, lines 56-64);

if the given message originated from a subscription source pre-approved by the given message's addressee, forwarding the given message to the addressee (column 9, lines 32-45);

if the given message did not originate from a subscription source pre-approved by the given message's addressee, blocking delivery of the given message to the addressee (column 9, lines 56-67).

Paul fails to disclose determining if incoming messages are subscription type messages.

However, Council teaches independent of whether incoming messages have originated from a message originator pre-approved by the messages' addressees, the subscription manager determining if incoming messages are subscription type messages, subscription type messages comprising recurring messages multicast to a

plurality of addresses who have previously communicated to originators of the messages their intent to receive such messages (column 4, lines 1-15).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Paul using the teaching of the service provider as taught by Council.

This modification of the invention enables the system to determine if incoming messages are subscription type messages so that the user would read the authorized messages.

Regarding **claim(s) 35 and 49**, Paul discloses a method, further comprising: responsive to determining that a given message is not a subscription type message, forwarding the given message to its addressee (column 7, lines 26-40).

Regarding **claim(s) 36 and 50**, Paul discloses a method, the operation of blocking delivery of the given message comprising at least one of the following: 1) refusing the given message, 2) returning the given message to its sender, 3) discarding the message, 4) prompting the given message's addressee for confirmation that the addressee requested the given message, and only upon receiving the confirmation, forwarding the given message to the addressee (column 7, lines 26-40).

Regarding **claim(s) 37 and 51**, Paul discloses a method, the operation of blocking delivery of the given message further comprising: presenting to the given

message's addressee an offer of a subscription to a machine-automated service of providing messages rejected to the given message, and only upon receiving acceptance of the offer, performing operations of forwarding the given message to the addressee (column 6, lines 20-40);

pre-completing a subscription activation form and providing the pre-completed form to the addressee (column 6, lines 20-40);

responsive to the addressee's acceptance of the form, on behalf of the addressee obtaining from a source of the given message a subscription to a machine-automated service providing future messages relating to the given message (column 6, lines 20-40).

Regarding **claim(s) 38, 52 and 62**, Paul discloses a method, where the subscription manager is operated remotely by a service provider on behalf of the user recipients (column 7, lines 26-40);

the operation of blocking delivery of the given message further comprises, only if the given message include evidence that the given message originated from a recognized business partner of the service provider, presenting the addressee with at least one of the following user-activated options: (1) to receive the message, (2) to obtain from a source of the given message a subscription to a machine-automated service providing future messages relating to the given message (column 7, lines 26-40).

Regarding **claim(s) 39 and 53**, Paul discloses a method, where the subscription manager is operated remotely by a service provider on behalf of the user recipients (column 8, lines 35-43);

the operations further comprise, apart from messages directed to the user recipients, the service provider receiving from recognized business affiliates of the service provider indicia identifying subscription type messages originating from said business affiliates (column 8, lines 35-43);

the operation of determining if incoming messages are subscription type messages comprises examining incoming messages for said indicia (column 8, lines 35-43).

Regarding **claim(s) 40 and 54**, Paul discloses a method, where the subscription manager is operated remotely by a service provider on behalf of the user recipients (column 6, lines 20-40);

the operations further comprise maintaining a record of machine-readable identifying indicia provided by business affiliates of the service provider and serving to uniquely identify each said business affiliate (column 6, lines 20-40);

the operation of determining that a given message is a subscription type message is satisfied by conditions including the given message including any of the identifying indicia (column 6, lines 20-40).

Regarding **claim(s) 41 and 55**, Paul discloses a method, where the operation of forwarding the given message to the addressee further comprises: including with the forwarded given message an indication that the subscription manager has approved the forwarded given message (column 8, lines 35-67).

Regarding **claim(s) 42 and 56**, Paul discloses a method, where the operation of, if the given message originated from a subscription source pre-approved by the given message's addressee, forwarding the given message to the addressee further comprises: determining which of the following that the given message pertains to: subscription maintenance or subscription content (column 6, lines 20-40);

making a different presentation of the given message to the addressee depending on whether the message pertains to subscription content or subscription maintenance (column 6, lines 20-40).

Regarding **claim(s) 43 and 57**, Paul discloses a method, where the operation of, if the given message originated from a subscription source pre-approved by the given message's addressee, the operation of forwarding the given message to the addressee further comprises: determining which of the following that the given message pertains to subscription maintenance or subscription content (column 6, lines 20-40);

only if the given message pertains to subscription maintenance, performing operations comprising: presenting the given message's addressee with a user-activated cancellation message (column 6, lines 20-40);

responsive to activation of the cancellation message, the subscription manager negotiating cancellation of the subscription with the subscription source free of further input by the given message's addressee (column 6, lines 20-40).

Regarding **claim(s) 44 and 58**, Paul discloses a method, where the operation of, if the given message originated from a subscription source pre-approved by the given message's addressee, forwarding the given message to the addressee further comprises: detecting whether the given message pertains to a new subscription requiring further acts by the addressee to activate the subscription, and if so, negotiating activation of the subscription with the subscription source free of further input by the given message's addressee (column 7, lines 26-40).

Regarding **claim(s) 45 and 59**, Paul discloses a method, the operation of determining whether the given message originated from a subscription source pre-approved by the given message's addressee comprising: determining whether at least one of the following attributes of the given message matches attributes stored in a subscriptions database origination address, alias origination address, proxy destination address, message subject, ID code name, other unique identifier field (column 7, lines 26-40).

Regarding **claim(s) 46 and 60**, Paul discloses a method, the messages being of at least one of the following types: email, instant messaging, telephonic, radio,

Art Unit: 2614

television, wireless, tem, audio, visual, and combinations thereof (column 6, lines 20-40).

Regarding **claim(s) 47 and 61**, Paul discloses a method, the operations further comprising: providing participating users with utilities for abbreviated creation, modification, and cancellation of subscription arrangements (column 8, lines 35-43).

Response to Arguments

8. Applicant's arguments with respect to **claim(s) 34-63** have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GERALD GAUTHIER
PATENT EXAMINER

GG

July 12, 2006